

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
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REMARKS

Claims 65 and 67-71 are pending in the subject application. Applicant has amended claims 65 and 69 to more particularly point out what applicant regards as the invention. Support for the amendment to claim 65 and 69 can be found, *inter alia*, in the specification at page 8, lines 5-23 and page 44, lines 19-38, respectively. Applicant maintains that this amendment raises no issue of new matter. Accordingly, claims 65 and 67-71 will be pending and under examination in the subject application upon entry of this Amendment.

In view of the arguments set forth below, applicant maintains that the Examiner's rejections made in the April 1, 2005 Final Office Action have been overcome, and respectfully requests that the Examiner reconsider and withdraw same.

Rejections under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 65 and 67-71 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner stated that the instant claims are drawn to antibodies that bind all allelic variants, analogs, fragments, or derivatives of human or mouse PAK4, but that the specification fails to disclose the structure and properties of the entire genus of PAK4 analogs, fragments and derivatives.

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In response to the Examiner's rejection, applicant respectfully traverses. Applicant notes that claim 65, as amended is limited to antibodies capable of binding to human PAK4 comprising the sequence set forth in SEQ ID NO:2 and that claim 69, as amended, is limited to antibodies capable of binding to mouse PAK4 comprising the sequence set forth in SEQ ID NO:14, respectively. Claims 67-68 and 70-71 are dependent on claims 65 and 69, respectively.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

Rejections under 35 U.S.C. §102(e)

The Examiner rejected claims 65 and 67-71 under 35 U.S.C. §102(e), as allegedly anticipated by Plowman et al., U.S. Patent Application Publication No. US 2003/0050230 ("Plowman"). Specifically, the Examiner stated that the 398 amino acid partial PAK5 sequence (SEQ ID NO:30) disclosed in Plowman is completely contained within, and is 100% identical to, the human PAK4 sequence set forth in SEQ ID NO:2 of the instant application and, therefore, antibodies capable of binding to the 398 amino acid PAK5 sequence would anticipate the antibodies of the instant invention. It is noted that the Plowman provisional patent application, U.S. Provisional Application No. 60/081,784, filed on April 14, 1998, only discloses the partial PAK5 sequence, SEQ ID NO:30, and not the full length 591 amino acid PAK5 sequence (SEQ ID NO:103) cited by the Examiner on page 6 of the Office Action.

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In response to the Examiner's rejection of claims 65 and 67-71, applicant respectfully traverses.

Again, claim 65 provides an antibody capable of binding to human PAK4 comprising the amino acid sequence set forth in SEQ ID NO:2. Claims 67 and 68 depend from claim 65. Claim 69 provides an antibody capable of binding to mouse PAK4 comprising the amino acid sequence set forth in SEQ ID NO:14. Claims 70 and 71 depend from claim 69.

Under 35 U.S.C. §102, and as stated in M.P.E.P. §2131.01, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added). Hence, to anticipate the antibodies of claims 65 and 67-71, Plowman would have to teach each and every element thereof.

Plowman fails to do this.

Without conceding the correctness of the Examiner's statements regarding Plowman, applicants maintain that Plowman fails to teach antibodies capable of specifically binding to either the human PAK4 comprising SEQ ID NO:2 or the mouse PAK4 comprising SEQ ID NO:14. Therefore, Plowman fails to teach each and every element of the claimed invention.

In view of the above remarks, applicant respectfully requests that claims 65 and 67-71 satisfy the requirements of 35 U.S.C. §102(e).

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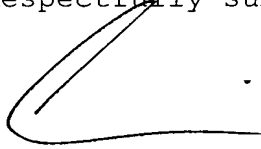
Summary

Applicant maintains that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

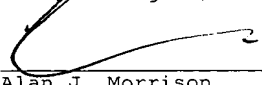
If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the \$450.00 extension fee, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450	
 Alan J. Morrison Reg. No. 37,399	<u>8/1/05</u> Date